

REMARKS:

Claims 1-20 are currently pending in the subject Application.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,012,046 to Lupien et al. ("*Lupien*") in view of U.S. Publication No. 2001/0032162 A1 to Alsberg et al. ("*Alsberg*") and in further view of U.S. Patent No. 6,172,428 to Jordan ("*Jordan*")

Claims 10-16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* and in further view of Official Notice.

Claim 7 stands rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* and *Jordan* and in further view of U.S. Patent No. 6,408,282 to Buist ("*Buist*").

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) over *Lupien*, in view of *Alsberg*, in view of *Jordan*, and in further view of *Buist*.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* and Official Notice and in further view of *Buist*.

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* and in further view of *Jordan*. Claims 10-16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* and in further view of Official Notice. Claim 7 stands rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* and in further view of *Jordan*. Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) over *Lupien*, in view of *Alsberg*, in view of *Jordan*, and in further view of *Buist*. Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Alsberg* Official Notice and in further view of *Buist*.

Applicant respectfully submits that *Lupien*, *Alsberg*, and *Jordan*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 1-6. Applicant further respectfully submits that *Lupien*, *Alsberg*, or the Examiner's Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 10-16, 19, and 20. Applicant still further respectfully submits that *Lupien*, *Alsberg*, and *Jordan*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claim 7. Applicant yet further respectfully submits that *Lupien*, *Alsberg*, *Jordan*, or *Buist*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 8 and 9. Applicant further respectfully submits that *Lupien*, *Alsberg*, or *Buist*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 17 and 18. Thus, Applicant respectfully traverses the Examiner's rejection of Claims 1-20 under 35 U.S.C. § 103(a) over the proposed combination of *Lupien*, *Alsberg*, *Jordan*, the Examiner's Official Notice, and *Buist*, either individually or in combination.

The Proposed *Lupien-Alsberg-Jordan* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to Claim 1, this claim recites:

A system for generating a display of at least one side of a market, the system comprising a computer system having one or more computers and operable to:

receive market data reflecting one or more offers, from a plurality of market participants, each offer comprising an offered price and an offered quantity;

provide a plurality of offer bars representing the one or more offers from the plurality of market participants;

divide each of the plurality of offer bars into one or more bar segments, each bar segment corresponding to a particular offer from a particular market participant;

prioritize each bar segment within the plurality of offer bars by vertically positioning each bar segment in the plurality of offer bars according to a prioritization scheme;

generate a display of the plurality of offer bars, the display comprising a price axis and a quantity axis, placement of each of the plurality of an offer bars along the price axis representing the offered prices for the one or more offers represented by each of the plurality of offer bars, height of each of the plurality of offer bars relative to the quantity axis representing an aggregate offered quantity for the one or more offers represented by each of the plurality of offer bars;

access an average price specified by a user;

calculate an offered quantity available at the specified average price based on the received market data; and

indicate the calculated offered quantity within the display of the received market data.

(Emphasis added). In addition, *Lupien, Alsberg, Jordan*, either individually or in combination, fails to disclose each and every limitation of Claims 10-14, 19, and 20.

The Office Action Acknowledges that *Lupien* Fails to Disclose Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Lupien* fails to disclose various limitations recited in Claim 1. Specifically the Examiner acknowledges that:

Lupien et al. does not teach:

receive market data reflecting the one or more offers, from a plurality of market participants, each offer comprising at least an offered price and an offered quantity;

provide a plurality of offer bars representing the one or more offers from the plurality of market participants, divide each of the plurality of offer bars into one or more bar segments, each bar segment corresponding to a particular offer from a particular market participant; prioritize each bar segment within the plurality of offer bars by vertically positioning each bar segment in the plurality of offer bars according to a prioritization scheme; generate a display of the plurality of offer bars, placement of each of the plurality of an offer bars offered for the one or more offers represented by each of the plurality of offer bars, height of each of the plurality of offer bars representing an aggregate offered quantity for the one or more offers

represented by each of the plurality of offer bars; based on the received market data; and indicate the calculated offered quantity within the display of the received market data;

(4 February 2009 Final Office Action, pages 2-3). However, the Examiner asserts that the cited portion of *Alsberg* somehow overcomes the acknowledged shortcomings in *Lupien*. Applicant respectfully traverses the Examiner's rejections based on the proposed *Lupien* and *Alsberg* combination.

Applicant respectfully submits that *Alsberg* fails to disclose Claim 1 limitations regarding ***“receiv[ing] market data reflecting one or more offers, from one or more market participants, each offer comprising an offered price and an offered quantity.”*** In particular, the Examiner alleges:

Alsberg et al. teaches:

receive market data reflecting the one or more offers, from one or more market participants, each offer comprising at least an offered price and an offered quantity (see Fig. 1 and 3; ¶ 0096);

(4 February 2009 Final Office Action, page 3). By contrast, the cited portion of *Alsberg* on which the Examiner relies does not disclose Claim 1 limitations regarding ***“receiv[ing] market data reflecting one or more offers, from one or more market participants, each offer comprising an offered price and an offered quantity,”*** as recited in Claim 1. In fact, Applicant respectfully directs the Examiner's attention to the cited portion of *Alsberg*, on which the Examiner relies:

FIG. 3 is a block diagram illustrating the components of an offer, consistent with the present invention. In one embodiment, market-clearing systems use offers, such as offer 302 and associated data structure 322, which correspond to buy and sell offers, such as buy offers 150 and sell offers 155 of FIG. 1. In one embodiment, an offer includes four components: a product specification 306, a quantity specification 308, a pool specification 310, and a price specification 312. For purposes of referencing an offer, offer 302 also includes an offer identifier such as offer ID 304. Product specification 306, quantity specification 308, pool specification 310, and price specification 312 are further described in FIGS. 4-7, respectively.

Applicant respectfully submits that the Examiner has mischaracterized the cited portion of *Alsberg*. For example, *Alsberg* merely discloses a block diagram illustrating the components of an offer, that is an offer, as defined by *Alsberg*, but ***does not include, involve, or even relate to***

receiving market data, as recited in Claim 1. (Figure 3, Paragraph [0096]). In contrast, “*receiv[ing] market data*” recited in Claim 1 *reflects one or more offers, from one or more market participants, each offer comprising at least an offered price and an offered quantity*. Applicant respectfully requests the Examiner to verify the references to *Alsberg*, to ensure that some mistake has not been made.

The Office Action Acknowledges that Proposed *Lupien-Alsberg* Combination Fails to Disclose Various Limitations Recited in Applicant’s Claims

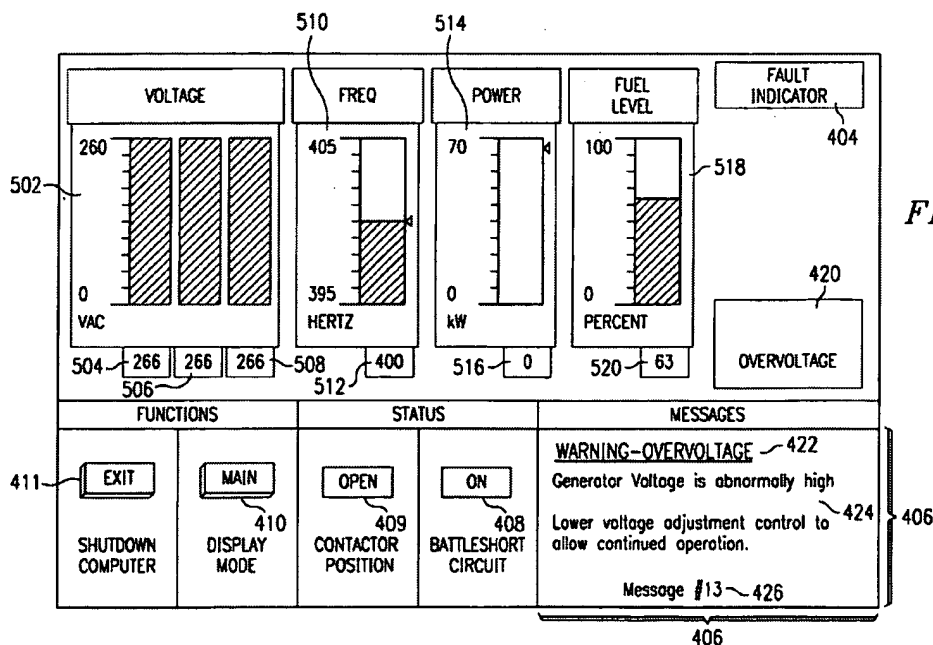
Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that the proposed combination of *Lupien* and *Alsberg* fails to disclose various limitations recited in Claim 1. Specifically the Examiner acknowledges that the proposed combination of *Lupien* and *Alsberg* fails to disclose “provide bars [...], divide each of the bars into one or more bar segments, each bar segment [...], prioritize each bar segment by vertically positioning each bar segment according to a prioritization scheme [...], and] generate a display of bars, placement of bars offered bars, height of bars representing an bars.” (4 February 2009 Final Office Action, page 4). However, the Examiner asserts that the cited portions of *Jordan* over the acknowledged shortcomings in the proposed combination of *Lupien* and *Alsberg*. Applicant respectfully traverses the Examiner’s rejections based on the proposed combination of *Lupien*, *Alsberg*, and *Jordan*.

Applicant respectfully submits that *Jordan* fails to disclose “divid[ing] each of the plurality of offer bars into one or more bar segments, each bar segment corresponding to a particular offer from a particular market participant,” “prioritiz[ing] each bar segment within the plurality of offer bars by vertically positioning each bar segment in the plurality of offer bars according to a prioritization scheme,” and “generat[ing] a display of the plurality of offer bars, the display comprising a price axis and a quantity axis, placement of each of the plurality of an offer bars along the price axis representing the offered prices for the one or more offers represented by each of the plurality of offer bars, height of each of the plurality of offer bars relative to the quantity axis representing an aggregate offered quantity for the one or more offers represented by each of the plurality of offer bars,” as required by Claim 1. In particular, the Examiner states:

Jordan teaches: provide bars (Fig. 5; column 13, lines 41-01umn 14, line 43; column 26, line 51-67); divide each of the bars into one or more bar segments, each

bar segment (Fig. 5; column 13, lines 41-column 14, line 43; column 26, line 51-67); prioritize each bar segment by vertically positioning each bar segment according to a prioritization scheme (Fig. 5; column 13, lines 41-column 14, line 43; column 26, line 51-67); generate a display of bars, placement of bars offered bars, height of bars representing an bars (Fig. 5; column 13, lines 41-column 14, line 43; column 26, line 51-67);

(4 February 2009 Final Office Action, page 4). By contrast, the cited portion of *Jordan* on which the Examiner relies does not disclose Claim 1 limitations regarding “divid[ing] each of the plurality of offer bars into one or more bar segments, each bar segment corresponding to a particular offer from a particular market participant,” “prioritiz[ing] each bar segment within the plurality of offer bars by vertically positioning each bar segment in the plurality of offer bars according to a prioritization scheme,” and “generat[ing] a display of the plurality of offer bars, the display comprising a price axis and a quantity axis, placement of each of the plurality of an offer bars along the price axis representing the offered prices for the one or more offers represented by each of the plurality of offer bars, height of each of the plurality of offer bars relative to the quantity axis representing an aggregate offered quantity for the one or more offers represented by each of the plurality of offer bars,” as required by Claim 1. In fact, Applicant respectfully directs the Examiner’s attention to Figure 5 as well as the cited portion of *Jordan*, on which the Examiner relies:



As shown, *delta VAC meter 405 may provide a bar graph and a numeric display that shows an operator at a glance whether there is a voltage difference across the output breaker*. Displaying the voltage difference across the output breaker provides an operator aid in paralleling gen-sets. If, for example, an operator notices that there is a 10 volt difference across the output breaker, the operator may adjust the gen-set to match what is on the other side of the breaker before closing the breaker. Failure to adjust the gen-set in this way may result in a much shorter life for the output breaker or damage the gen-set. Therefore, monitoring both sides of the output breaker may work to increase the operator's ability to operate a gen-set safely and extend the life of the hardware.

(Figure 5 and column 26, lines 50-64). (Emphasis added). Applicant respectfully submits that the Examiner has mischaracterized the cited portion of *Jordan*. For example, *Jordan* merely discloses a *bar graph and a numeric display that shows an operator at a glance whether there is a voltage difference across the output breaker*, but *does not include, involve, or even relate to* dividing each of the plurality of offer bars into one or more bar segments, prioritizing each bar segment within the plurality of offer bars by vertically positioning each bar segment in the plurality of offer bars according to a prioritization scheme, and generating a display of the plurality of offer bars, wherein placement of each of the plurality of an offer bars along a price axis representing the offered prices for the one or more offers represented by each of the plurality of offer bars, height of each of the plurality of offer bars relative to a quantity axis representing an aggregate offered quantity for the one or more offers represented by each of the plurality of offer bars, as required in Claim 1. (Figure 5 and column 26, lines 50-64). In fact, Applicants find no such teachings anywhere in *Jordan* and certainly not in the portions of *Jordan*, cited by the Examiner.

Therefore, introducing *Jordan* into the proposed combination fails to render obvious the affirmatively claimed action of “divid[ing] each of the plurality of offer bars into one or more bar segments, each bar segment corresponding to a particular offer from a particular market participant,” “prioritiz[ing] each bar segment within the plurality of offer bars by vertically positioning each bar segment in the plurality of offer bars according to a prioritization scheme,” and “generat[ing] a display of the plurality of offer bars, the display comprising a price axis and a quantity axis, placement of each of the plurality of an offer bars along the price axis representing the offered prices for the one or more offers represented by each of the plurality of offer bars, height of each of the plurality of offer bars relative to the quantity axis representing an aggregate offered quantity for the one or more offers represented by each of the plurality of offer bars” because,

among other things the disclosure of *Jordan* fails to yield any result (i.e., merely providing *a bar graph and a numeric display that shows an operator at a glance whether there is a voltage difference across the output breaker*) let alone a predictable result for the above-referenced elements of Claim 1. Accordingly, Applicant respectfully requests that the rejection of Claims 1-6 as obvious over the proposed combination of *Lupien*, *Alsberg*, and *Jordan* be withdrawn and Claims 1-6 be allowed.

The Examiner's Official-Notice is improper under MPEP § 2144.03

Applicant respectfully submits that Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. *Applicant respectfully traverses the Official Notice because the asserted facts*, as best understood by Applicant, *are not supported by substantial documentary evidence or any type of documentary evidence* and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). *Applicant respectfully requests the Examiner to produce authority for the Examiner's Official Notice.*

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence *should only be taken by the examiner* where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*."

With respect to the subject Application, the Examiner's statement that:

Official Notice is taken that generate a display of the received market data, the display comprising a price axis, a quantity axis, and one or more offer bars, each offer bar representing one or more offers comprising substantially equal offered prices, placement of an offer bar along the price axis representing the substantially equal offered prices for one or more offers represented by the offer bar, height of an offer bar relative to the quantity axis representing an aggregated offered quantity for the one or more offers represented by the offer bar; based on the received market

data; and indicate the calculated offered quantity within the display of the received market data feature is old and well known in the trading business as a convenient way for buyer/seller to analyze or visualize market data.

(4 February 2009 Final Office Action, pages 8-19). The Examiner's statement *is not capable of instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '*capable of such instant and unquestionable demonstration as to defy the dispute*' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is *never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record*, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that *general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection*). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. Applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject Application, *the Examiner has not properly Officially Noticed or not properly based the Official Notice on common knowledge*. The Examiner's conclusory statement:

Official Notice is taken that generate a display of the received market data, the display comprising a price axis, a quantity axis, and one or more offer bars, each offer bar representing one or more offers comprising substantially equal offered prices, placement of an offer bar along the price axis representing the substantially equal offered prices for one or more offers represented by the offer bar, height of an offer bar relative to the quantity axis representing an aggregated offered quantity for the one or more offers represented by the offer bar; based on the received market data; and indicate the calculated offered quantity within the display of the received market data feature is old and well known in the trading business as a convenient way for buyer/seller to analyze or visualize market data.

(4 February 2009 Final Office Action, pages 8-19). The above noticed Examiner's conclusory statement *does not adequately address the issue that this statement is considered to be common knowledge or well-known in the art.*

Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. *Applicant respectfully requests the Examiner to produce authority for the Examiner's statement of Official Notice.*

Applicant further respectfully submits that *Applicant has adequately traversed the Examiners assertion of Official Notice.* In addition, with respect to the Examiner alleged statements that

The applicant does not properly traverse the Official Notice. Therefore, the Official Notice is the admitted prior art now.

(4 February 2009 Final Office Action, pages 8-19). Applicant respectfully disagrees and respectfully submits that the *Applicant has in fact adequately traversed the Examiners assertion of Official Notice* and respectfully submits that the Examiner's purported Official Notice is not admitted prior art and is clearly not admitted prior art. In addition, Applicant respectfully directs the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the

finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Applicant's claims based on the Official Notice, Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Lupien-Alsberg-Buist-Official-Notice* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner's Official Notice, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As

stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “*ensure that the written record includes findings of fact* concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner’s Official Notice. Applicant respectfully submits that the Examiner’s conclusory statements are not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner’s Official Notice. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (*See Phillips*

v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill. Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Lupien, Alsberg, Jordan, Buist, the Examiner’s Official Notice, and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.* Applicant respectfully requests clarification as to how the Examiner’s statements *explains why the difference(s) between the proposed combination of Lupien, Alsberg, Jordan, Buist, the Examiner’s Official Notice and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.* Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted

that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (KSR, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicants claimed invention would have been obvious.* For example, the *Examiner has not adequately supported the selection and combination of Lupien, Alsberg, Jordan, Buist, and the Examiner’s Official Notice to render obvious Applicant’s claimed invention.* The *Examiner’s unsupported conclusory statements do not adequately provide clear articulation of the reasons why Applicants claimed invention would have been obvious.* In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicants claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner’s Official Notice, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection*

under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.

Applicant's Claims are Patentable over the Proposed *Lupien-Alsberg-Jordan-Buist-Official-Notice* Combination

Applicant respectfully submits that Claims 1, 10-14, 19, and 20 are considered patentably distinguishable over the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner's Official Notice. This being the case, Claims 1, 10-14, 19, and 20 are considered patentably distinguishable over the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner's Official Notice.

With respect to dependent Claims 2-9 and 15-18: Claims 2-9 depend from Claim 1 and Claims 15-18 depend from Claim 14. As mentioned above, each of Claims 1, 10-14, 19, and 20 are considered patentably distinguishable over *Lupien, Alsberg, Jordan, Buist*, and the Examiner's Official Notice. Thus, dependent Claims 2-9 and 15-18 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-20 are not rendered obvious by the proposed combination of *Lupien, Alsberg, Jordan, Buist*, and the Examiner's Official Notice. Applicant further respectfully submits that Claims 1-20 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-20 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-20 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

4 April 2009
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

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